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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,371

08/01/2003

Scott A. Webb

5259-14600

5117

35690

7590

04/01/2009

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,371	<b>Applicant(s)</b> WEBB ET AL.	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-13, 15-17, 20-23, 25-39, 41, 42, 44-54, 57, 58, 96 and 97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 15-17, 20-23, 25-39, 41, 42, 44-54, 57, 58, 96 and 97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 February 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-13, 15, 20-23, 25-39, 41, 42, 44-54, 57, 58, 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biscup (6,245,108) alone; *or, in the alternative*, over Biscup in view of Boyd et al. (6,468,311).

Biscup discloses a spinal implant comprising a top, 20, a bottom, 30, a curved anterior side, 60, a curved posterior side, 70, (see column 4, lines 16-17 and column 10, lines 44-46) and an opening, 130, extending through the spinal implant from the top to the bottom, protrusions, 80, a recess, 150, groove, 140 (see figures 1 and 2). The

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proximal end can be substantially flat or rounded and the distal end can be tapered or curved (see figures 1 and 2 and column 5, lines 37-48).

The protrusions can differ in height, pattern, shape, spacing, coarseness and fineness (see column 4, lines 38-62). The implant can comprise bone, polyether ether ketone, metal, titanium, one or more openings for X-ray sensitive material, the top can be treated to promote osseointegration of the implant with bone, the top can be roughened to promote fusion of the spinal implant with bone, and the opening can receive packing material (see column 3, lines 56-67, column 4, lines 1-10, and 38-67, column 5, lines 1-36, and column 10, lines 32-37).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Biscup, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Biscup teaches the claimed invention except for explicitly reciting that the implant can comprise two curved sides so as to be substantially kidney-shaped. However, it would have been obvious to have formed the second side wall 70 of Biscup to be non-

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planar, e.g., curved, in order to provide longer walls and hence to have more contact between the implant upper and lower wall surfaces and the surfaces of the vertebrae (see, e.g., Biscup, col. 9, lines 3-7 and 12-15). Determining a range of curvatures in such an instance, including wherein the sidewall curvatures 60 and 70 are substantially similar, would involve only routine skill in the art, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Alternatively, it would have been obvious to have provided the implant of Biscup with curved sides so as to be substantially kidney-shaped in view of Boyd et al. Biscup discloses that "the implant can be used with a modular component that can be attached and assembled between two implants to create a construct (ALIF type) cage." (see col. 11, lines 25-27). Boyd et al. disclose such an implant construct 10 comprising a modular component 28 assembled between two substantially kidney shaped implants 12 and 13 (see, e.g., Figs. 1, 2 and 3a, Abstract, col. 2, lines 15-32, col. 4, lines 35-42). This configuration provides a substantially rigid structure that inhibits movement of the lateral spacers and provides support near the outer wall of the vertebra, while still allowing for a minimally-invasive surgery. It would have been obvious to a person having ordinary skill in the art to have provide the implants of Biscup with a substantial kidney shape and a construct therebetween, in view of Boyd et al., in order to provide a substantially rigid structure that inhibits movement of the lateral spacers and to provide support near the outer wall of the vertebra, while still allowing for a minimally-invasive surgical procedure. It is noted that even absent the teachings of Biscup and Boyd et al.

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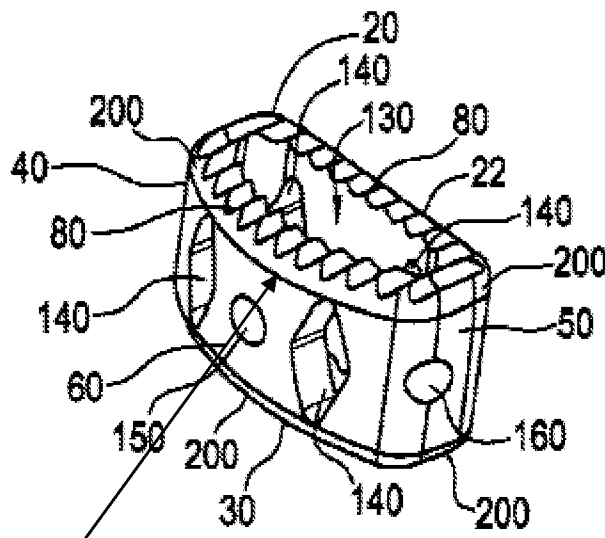
regarding the curved walls and kidney-shape, it would have been obvious to have formed the implant of Biscup with curved walls and a kidney shape as doing so is old and well-known in the art of spinal implants (as evidenced by, for example, the art which has been cited on the accompanying PTO-892, which is only a sampling of the numerous implants having such a configuration).

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biscup (6,245,108) alone; or, alternatively, over Biscup in view of Boyd et al. (6,468,311), as set forth above, and further in view of Ross et al. (US Patent Publication Number 2005/0004671).

The device of Biscup, or alternatively, the device of the combination of Biscup and Boyd et al., discloses the claimed invention except an inner surface of the anterior side and an inner surface of the posterior side each comprising one or more projections extending into the opening. Ross et al. disclose a spinal implant and an inner surface of the anterior side and an inner surface of the posterior side each comprising one or more projections extending into the opening (see figure 5-7). In addition, Ross et al. teach the use of the projections as support structures (see paragraph 0048). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Biscup or the device of the combination of Biscup and Boyd et al., with an inner surface of the anterior side and an inner surface of the posterior side each comprising one or more projections extending into the opening, in view of Ross et al., in order for the projections to serve as support structures for the implant.

***Response to Arguments***

Applicant's arguments filed 26 February 2009, with respect to the claims, as now amended, have been considered but are not persuasive. Upon further consideration, it is noted that what may be considered the "top" and the "bottom" is open to varying interpretation. For example, the "top" can comprise the top edge and the top surface (see arrow indicating line where the "top" can be seen as beginning. Similarly, the "bottom" could be considered to begin at a respective portion. As such, it appears that the groove extends from the top to the bottom. Moreover, the groove is equidistant from the end.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733